

1 require the application to be restricted to one of the inventions.” 35 U.S.C. 121 (emphasis
2 added). The Examiner’s restriction is not predicated upon the claims of the pending application,
3 but rather the figures. Figures of a patent application do not define the scope of the applicant’s
4 claimed invention. *See Kaplan v. Robertson*, 50 F.2d 617, 620 (D.Md. 1931) (Description of
5 invention as contained in claims, interpreted in light of specifications, is to be neither restricted
6 nor extended by drawings). *See, also, Harvey Hubbell, Inc. v. General Electric Co.*, 267 F. 564,
7 570 (2d Cir. 1920). Rather, the scope of the applicant’s invention is defined by the claims. *See*
8 35 U.S.C. 112 ¶ 2 (“The specification shall conclude with one or more claims particularly
9 pointing out and distinctly claiming the subject matter which the applicant regards as his
10 invention.”); *See, also, Ziegler v. Phillips Petroleum Co.*, 483 F.2d 858, 869, 177 U.S.P.Q. 481
11 (5th Cir. 1973), *certiorari denied*, 94 S.Ct. 597, 414 U.S. 1079, 38 L.Ed.2d 485, 180 U.S.P.Q. 1
12 (Claims delineate scope of protection afforded by a patent, not specific embodiments shown in
13 patent drawings). Consequently, the Examiner’s restriction is improper because it fails to
14 identify which, if any, claims support the existence of “two or more independent and distinct
15 inventions” within the subject application. Consequently, the subject Office Action to be
16 incomplete, non-informing, and improper pursuant to § 707.07(d) of the Manual of Patent
17 Examination Procedure. Section 707.07(d) states “where a claim is refused for any reason
18 relation to the merits thereof it should be ‘rejected’ and the ground of rejection fully and clearly
19 stated . . .” M.P.E.P. §707.07(d). The Examiner’s restriction fails to “fully and clearly” identify
20 which, if any, claims constitute “two or more independent and distinct inventions.”

21 Moreover, a restriction is unnecessary in this case because there is a unity of invention,
22 i.e., a common inventive concept. *See* 37 C.F.R. 1.476(d). All embodiments of the claimed
23 invention claim the identical inventive concept of a means for reinforcing a plurality of parallel
24 studs whether in the shape of a wall panel (with or without an aperture for a window or door), a
25 floor panel, a ceiling panel, or a truss. Specifically, the common inventive concept claimed
26 comprises:

27 a means for reinforcing said plurality of studs comprising a unitary
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1 elongated metal plate-like member formed of a finite length
2 defined by two parallel upright studs terminating in a first end and
3 a second end, said unitary plate-like member possesses a first
4 horizontal edge and a second horizontal edge between the first end and
5 second end; a first flange extending perpendicularly upwards
6 from said first end and a second flange extending perpendicularly
7 upward from said second end to permit fastening to the adjacent
8 studs, said first end of the elongated metal plate incorporates a pair
9 of parallel notches along the horizontal axis, said first horizontal
10 edge and the second horizontal edge of the elongated plate are
11 folded downward and perpendicular to the elongated plate forming
12 a first downward flange and a second downward flange, said first
13 downward flange of the first horizontal edge is substantially longer
14 than the second downward flange of the second horizontal edge
15 and the width of first downward flange extends to and overlaps the
16 adjacent parallel upright studs which define the width of said
17 elongated plate-like member located between each stud member
18 whereby said assembly can support excessive loads due to weight,
19 wind, or sheer forces;

20 Therefore, a restriction is inappropriate in this case for any purpose, including for
21 purposes of conducting the prior art search.

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1 If the Examiner and the Examiner's Supervisor wish to discuss this response in further
2 detail, Applicant invites both the Examiner and Examiner's Supervisor to contact undersigned
3 counsel at (714) 374-9160.

4 Respectfully Submitted,

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7 November 7, 2005
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9 PLEASE RESPOND TO:



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